

### **Restriction Requirement**

Applicant's provisional election of the claims of Group I is acknowledged. However, paragraph 2 of the Office Action erroneously states that "[i]nventions I and II" are related as process of making and product made. While the application discloses and claims a customer registration system, namely, the system of claims 1 through 11 and 15, no process for making same has been claimed. Also, the Examiner's characterization of the invention as a "labelling system" is respectfully traversed as being inaccurate. As the title of the invention and the preambles to claim 1 (now cancelled) and new claim 15 both indicate, the elected invention is a customer registration system. Applicant also respectfully traverses the statement in paragraph 2 of the Office Action that "[i]n the instant case the labeling system can be used to label food to indicate the oldest food to avoid spoilage". Applicant does not believe the present invention is useful for that purpose.

### **Request for Approval of Drawing Changes**

The Examiner's approval of changes to Figs. 1, 3A and 3B is requested. In Fig. 1, it is proposed to provide additional reference numerals 122 to identify the indicia 122 of each label 101-122, as well as a reference numeral 124 identifying the area or field in which the customer may enter information on each label. Similarly, in Figs. 3A and 3B, it is proposed to provide reference numerals 324 to identify the corresponding indicia associated with each label-retaining space 301-320 and to add reference numerals 301-305. Repositioning of reference numerals 306-320 for improved clarity is also proposed.

Copies of Figs. 1, 3A and 3B with the foregoing proposed changes marked thereon in red are enclosed for review and approval by the Examiner.

#### **Amendments to the Specification**

Original Claim 1 used the term "area" in reference to both the place where information is entered by a customer on a registration label and the description of the label-retaining spaces. To avoid any potential confusion, the term "field" is now used in claim 15 to refer to the former. The Specification has been amended correspondingly at pages 4 and 6. The proposed revisions to Fig. 1 include addition of a reference numeral 124 to identify the field.

The Specification has been amended at page 11 to make clear that the security features noted pertain to described embodiments of the invention and do not limit the scope of the claims.

#### **Rejection Under 35 U.S.C. §112**

Claims 1-11 have been rejected under 35 U.S.C. §112, second paragraph on the basis it was unclear to the Examiner how the indicia are "unique".

Claim 1 has been cancelled in favor of new claim 15 which does not use that term. Likewise, Claims 2, 9 and 10 have been amended as to no longer describe the recited indicia being "unique" as this, of course, is unnecessary. As recognized by the Examiner in paragraph 8 in the second and third lines of page 4 of the Office Action, the indicia serve to identify position in a sequential arrangement. Any

indicia indicative of such a sequential arrangement can be used. As disclosed in the specification, indicia representing the members of a sequence of numbers and/or alphabetical letters are non-limiting examples of suitable indicia. According to these amendments, the indicia on the labels are now simply referred to as "first indicia" and the indicia associated with each label-retaining space are referred to as "second indicia". That amendment is believed to overcome the rejection under 35 U.S.C. §112 second paragraph. Reconsideration and withdrawal of that rejection is therefore requested.

### **Rejections Under 35 U.S.C. §103**

Claim 1 has been cancelled in favor of new Claim 15.

Claims 1 through 11 stand rejected under 35 U.S.C. §103 over *Templet* '364 in view of *Jackson* '090. The Examiner contends "there is no novel and unobvious functional relationship between the printed matter "and that the invention would therefore be obvious over *Templet* '364 in view of *Jackson*. For the reasons set forth below, Applicant respectfully disagrees and requests reconsideration and withdrawal of this rejection, particularly in light of newly presented Claim 15 and the amendments discussed below.

At the outset, it is noted that the Examiner should appreciate that there is a significant functional relationship between the indicia (122) (first indicia) on the registration labels (101-120) associated with the first substrate and the corresponding indicia (324) (second indicia) associated with the label-retaining

spaces 324 and that the relationship is one which provides significant functional benefits. According to the Examiner:

"The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of label system does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability".

Office Action at p. 4.

That contention is not correct. The relationship between the substrates and indicia as recited in new Claim 15 as well as its cancelled predecessor goes well beyond one providing support for the other and is indeed a functional relationship. The correspondence between the indicia 122 identifying the position of each registration label 101-120 in a sequential arrangement and the corresponding indicia 324 identifying the corresponding label-retaining spaces 301-320 provides a security function which is expressly noted in the original Specification at page 11, lines 8-11. Namely, the correspondence between those indicia ensures that each registration label 101-120 is placed in the appropriate space 301-320 of the registration log. By so doing, it can readily be verified by visual inspection that each registration label on which a customer has entered information has been in the registration log. This is advantageous for two reasons. First, it helps protect the confidentiality of the information entered on the labels by facilitating confirmation that every label that has been filled out by a customer is present in the registration log and has not been lost or stolen. Secondly, the recited correspondence between

the indicia on the registration labels and those identified on the label-retaining spaces in the registration log deters fraud and theft. For example, in the absence of the recited correspondence, a dishonest receptionist at a physician's office might detach a completed label from the first substrate after it had been filed out by a patient and deliberately not place the completed label in the registration log in order to steal a cash co-payment received from that patient without detection. Since there would be no record of that patient in the registration log, the theft might not be detectable. The invention as claimed provides a deterrent to such dishonest behavior. By providing the recited correspondence between the indicia (first indicia) on the substrate (first substrate) which initially carries the labels and the (second indicia) on the substrate to which the labels are subsequently attached after being filled out by a customer, it can readily be determined whether a label had been removed from the first substrate, but not placed in the registration log. In addition, the recited uninterrupted sequential arrangement of registration labels provided by the first indicia makes it possible to determine the approximate window of time in which a label went missing. Such information would be of great value in an audit or investigation of the reason for a missing registration label.

In view of the foregoing, it can readily be appreciated that Claim 15 defines a functional relationship between substrate and printed matter that is not at all merely one of physical support as the Examiner has asserted. Accordingly, the Examiner has erred by not properly considering the role of the recited indicia (printed matter) in assessing the patentability of the invention and reconsideration

and withdrawal of this ground of rejection is solicited. Moreover, the combination of *Templet '364* and *Jackson '090* postulated by the Examiner, is not a proper one and cannot be relied on to support the rejection of claims 1-11 under 35 U.S.C. §103 or to likewise reject new claim 15 for reasons that will now be explained.

*Templet '364* does not disclose or suggest any type of customer registration system, much less one which would render obvious Applicant's invention as claimed. As its title indicates, *Templet '364* instead deals with a "label-providing log for facsimile transmissions" and a corresponding method. In particular, it discloses a log which includes release-backed adhesive labels (16) which can be filled out with the usual sender/recipient information. As each label (16) is filled out, the information is carbonlessly duplicated onto a lower sheet (15) which serves as a log. Each label (16) is then peeled free of the upper sheet (14) on which it is initially provided and attached to a piece of correspondence to provide a facsimile transmission label for the correspondence.

As Applicant's Specification and the preamble and body of claim 15 point out, Applicant's invention is a registration system that protects the confidentiality of information provided by a customer. (See: e.g., Specification at p. 3, lines 21-25; p. 5, lines 16-21 and p. 14, lines 1-4). The Examiner's postulated combination of *Templet '364* and *Jackson '090* would completely frustrate that fundamental objective.

The Examiner contends it would have been obvious to "modify the invention of *Templet '364* to include indicia that comprises indicia sequentially arranging the

labels, as taught by *Jackson*, to aid in properly applying the labels in the log according to a particular criteria set forth by the user (e.g., date received, time received, etc.)" (Office Action p. 4). This modification would do nothing to protect the confidentiality of the information entered on the labels. To the contrary, information filled in by a user on a label would remain in plain view of subsequent users filling out remaining labels. This is readily apparent from Fig. 5 of *Templet* '364 and the description thereof at Col. 2, lines 21-41 which explains that upon completing a label (16) and peeling it free of the upper sheet (14) and affixing it to a document to be sent via facsimile, all of the information entered on the label (16) is carried through to the lower sheet (15) which serves as a permanent log. In other words, as information is entered onto a label (16), it is simultaneously visibly copied verbatim onto the corresponding lower sheet (15). Thus, as Fig. 5 of *Templet* '364 clearly shows, the information entered remains on lower sheet (15) in permanent and plain view of users who subsequently fill in the remaining labels (16). As a result, the confidentiality of the entered information would be lost. The modification proposed by the Examiner in view of *Jackson* '090 would do nothing to cure the glaring inability of *Templet* '364 to protect the confidentiality of the entered information.

In order to support a rejection under 35 U.S.C. §103 based on a combination of prior art references, there must be some teaching, suggestion or motivation that would lead a person of ordinary skill in the art to make the combination. In re: Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998):

"the question is whether there is something in the prior art as a whole to suggest the desirability and thus, the obviousness of the modification".

In re: Rouffet, *supra* at 1456. In the same decision, the Court went on to note that the Examiner:

"must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the prior art references for combination in the manner claimed".

In re: Rouffet, *supra*, at 1458.

Applying these standards, it is clear that the postulated modification of *Templet* '364 and *Jackson* '090 would never be made by a person of ordinary skill confronted with the problem of registering customers in a way which protects the confidentiality of the information they enter since doing so would compromise, rather than protect, the information of concern. A combination which exacerbates rather than solves the problem confronting the inventor cannot properly be construed as rendering the claimed invention obvious. Moreover, the postulated combination would not result in or render obvious the invention defined by claim 15 or any claims depending therefrom.

It appears that the Examiner has misconstrued *Templet* '364. In paragraph 8 of the Office Action, the Examiner states:

"*Templet* discloses... a log including a second substrate (15) having a plurality of label-retaining spaces for receiving the labels (see col. 2 lines 31-34)".



It is respectfully submitted that statement is in error and has led the Examiner to draw the erroneous conclusion stated in the sentence immediately following in the same paragraph of the Office Action, namely that:

"*Templet* discloses the claimed invention except for the specific arrangement and/or content of indicia (e.g. indicia that corresponds to a position of the registration label in a sequential arrangement) set forth in the claims".

In actuality, *Templet* '364 neither discloses nor suggests providing label-retaining spaces for receiving the labels.

As pointed out above, the labels (16) in *Templet* '364 are filled out, peeled from their backing and attached to a piece of facsimile correspondence. They are not attached to the lower sheet (15) which the Examiner attempts to analogize to the second substrate recited in Applicant's claims. Doing so would frustrate the expressly stated purpose of *Templet* '364 of providing a facsimile label in order to eliminate the cost associated with providing a fax cover sheet (See: Col. 1, lines 14-18). If label (16) of *Templet* '364 were attached to its lower sheet (15) as the Examiner suggests, the label (16) would not be available to attach as a label to facsimile correspondence in lieu of a cover sheet. A separate label or cover sheet would be required and someone would have to enter on it the same information previously entered on the label (16).

There is also another reason why a person of ordinary skill in the art would have no motivation to attach a completed label (16) of *Templet* '364 to the lower sheet (15) instead following the express teaching of attaching the label (16) to the

correspondence. Namely, all of the information on label (16) is already present on lower sheet (15) having been carbonlessly carried through to the lower sheet (15) as the label (16) was being filled out.

Since a combination of *Templet* '364 and *Jackson* '090 cannot reasonably be construed as including or even suggesting the combination of claim 15, including "a second substrate having a plurality of label retaining spaces" as recited, those references, either alone or in combination, cannot support a rejection of claim 15 or any of its dependents 2 through 11. As pointed out above, the postulated combination of those references is also improper since it would frustrate a fundamental objective of Applicant's invention namely, improving protection of the confidentiality of information entered on the label. By duplicating the entered information on a carbonless copy which remains in view of those who fill out labels later, the postulated combination compromises, rather than protects, confidentiality.

It is also to be noted that one could not even remove the lower sheet (15) from *Templet* '364 and place it elsewhere once a label (16) had been filled in. If that were done, the lower sheet (15) would no longer be available to receive carbonless duplicates of the other labels (16) present on a given upper sheet (14). As a result, the information entered on the remaining labels (16) would not be properly logged, thereby thwarting the intended logging function of *Templet* '364.

In view of the foregoing, it will readily be appreciated that claim 15 clearly patentably distinguishes the invention over the prior art of record, including

without limitation, *Templet* '364 and *Jackson* '090, either alone or in any proper combination with one another. The prior art of record lacks any teaching or express or implied suggestion of providing a customer registration system which includes not only a first substrate with a plurality of registration labels with sequence indicia as recited detachably adhered to the first substrate as well as a registration log including a second substrate having a plurality of label-retaining spaces and second indicia associating the label-retaining spaces with corresponding ones of the labels.

Claim 15 is even further distinguished over the prior art of record in that it recites that the first location is one sufficiently accessible to the customer to permit the customer to view the labels adhered to the first substrate and enter the information thereon while the labels remain detachably adhered to the first substrate and enter the information thereon while the labels remain detachably adhered to the first substrate while the second substrate is locatable in a second location at which the entered information on any labels adhered to it is out of customer view, at the same time the first substrate is located at the first location. In other words, the first substrate can be at one location for viewing and entry of information while, at the same time, the second substrate can be located elsewhere where the information entered on those labels which may have previously been detached from the first substrate and attached to the second substrate is kept from customer view. It should readily be apparent that the structure disclosed in *Templet* '364 and *Jackson* '090 either alone, or in combination, does not meet this

limitation. As pointed out above, in *Templet* '364, the lower sheet (15) that the Examiner sought to analogize to Applicant's recited second substrate does, and as noted above, must remain in place in view of those at the same location where information is entered on labels (16). Removing lower sheet (15) from *Templet* '364 once a given label (16) was filled out would not be possible without destroying the ability of that log to carry out one of its primary functions, namely to receive on the lower sheet (15) a carbonless duplicate of all the labels (16) in order to provide a complete log record of them.

Claim 15 also distinguishes over *Templet* '364 in another important respect beyond protecting the confidentiality of the information entered by users. Unlike the second sheet (15) of *Templet* '364, which retains only a carbonless copy of the information entered on a fax label (16), Applicant's invention as expressly recited in claim 15 provides a system in which the labels adhered to the second substrate provide an *original* record of the writing entered on the labels and not merely a copy of that writing. For evidentiary and audit purposes, an original of a writing is preferable to a mere copy.

Claims 2 through 11 inclusive have been amended to depend from new claim 15. Accordingly, each of those claims is respectfully submitted to be patentable over the prior art of record for at least the same reasons pointed out above as to claim 15.

Claim 2 has also been amended for conformity with the terminology used in claim 15 and to refer to the indicia defining a sequential order of second substrates simply as "third" indicia rather than the using the term "unique" to which the

Examiner had taken exception. The word "further" has been added only for clarity as an indicator that other aspects of the second substrate are defined in claim 15.

Claim 3 has been amended to likewise include the word "further" and to delete the unnecessary term "manually".

Claim 4 has also been amended slightly for clarification to conform to the terminology of claim 15 and to recite that the second substrate includes the recited text associated with the label-retaining spaces. While such text is included within each label-retaining space in the preferred embodiment shown in Figs. 3A and 3B, it is not necessary to place it within the label-retaining spaces.

Claim 5 has also been amended to conform to the terminology of claim 15 as well as for improved clarity.

Claim 6 has been amended to conform to the terminology of claim 15 and has been re-worded for improved clarity. In addition to being patentable for at least the reasons noted above concerning claim 15, it is respectfully submitted that none of the prior art of record discloses or suggests a customer registration system of the type recited in claim 15 wherein the registration labels are provided in sets at least one of which has the same sequencing indicia as another of those sets. Accordingly, claim 6 is independently patentable on grounds over and above those which support claim 15.

Claims 7 and 8 have also been amended to conform to the terminology of claim 15. In order to more particularly point out the inventions of these claims, it is now recited that the first and second surfaces are "mutually opposed".

The Examiner's comments regarding claims 2-6 and 7 through 11 are noted. However, as noted, each of those claims appear to be patentable over the prior art for at least the reasons noted above concerning claim 15 from which each of them depends. Claim 6 is submitted to also be patentable on the independent and distinct grounds noted above respecting claim 6.


The prior art cited by the Examiner but not relied on as a basis for rejection is noted but is not believed to bear on the patentability of any of the pending claims.

### Conclusion

In view of the foregoing, it is respectfully submitted that all claims in their present form are patentable over the prior art of record. Accordingly, a prompt Notice of Allowance is solicited.

Respectfully submitted,

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Enclosures

## Marked-up Version of The Claims and Specification

### CLAIMS

2. (Once Amended) The customer registration system of claim 1,15, wherein said registration log includes more than one said second substrate~~includes a unique and each said second substrate further includes third~~ indicia to identify a sequential order of said second ~~substrates~~substrates in said registration log.

3. (Once Amended) The customer registration system of claim 1,15, wherein said second substrate further includes a designated area for a user of the system to ~~manually~~ enter a date on which services were provided to the customer.

4. (Once Amended) The customer registration system of claim 1, wherein ~~each label retaining space includes text instructing a user of the system to attach a registration label~~15, further comprising text associated said label-retaining spaces, said text including instructions to attach said labels in said label-retaining ~~spaces~~spaces.

5. (Once Amended) The customer registration system of claim 1,15, wherein said plurality of registration labels are ~~arranged sequentially on a first detachably adhered to respective ones of a plurality of substrates, each of said registration labels being detachable from a respective one of said first plurality of~~said first substrates, and wherein said at least a second substrate ~~comprises a second~~registration log includes a plurality of said second substrates, each of said second ~~plurality of~~ substrates including a plurality of label-retaining spaces arranged sequentially thereon for retaining at least some of said ~~registration labels~~ after entry of information on said ~~registration labels~~ by additional customers and detachment thereof from said first substrates.

6. (Once Amended) The customer registration system of claim 1,15, wherein said plurality of ~~registrations~~said labels are arranged in sets ~~on a plurality of substrates, such that each of said plurality of substrates hosts a single set of registration labels and each set of registration labels is sequentially arranged only~~

7. within said set, each of said sets having a given said sequence of said first indicia and wherein at least two of said sets have the same said sequence of said first indicia.

7. (Once Amended) The customer registration system of claim 1,15, wherein said first substrate includes a first surface and a mutually opposed second surface and wherein said plurality of ~~registration-labels are arranged on~~adhered only to said first surface ~~of said first substrate only.~~

8. (Once Amended) The customer registration system of claim 1,15, wherein said second substrate includes a first surface and a mutually opposed second surface and wherein said plurality of label-retaining spaces are disposed on both said first surface and said second surface.

9. (Once Amended) The customer registration system of claim 1,15, wherein said ~~unique~~first indicia of said ~~registration-label~~ comprises at least one of a numeral and a letter of the alphabet.

10. (Once Amended) The customer registration system of claim 1,15, wherein said ~~unique~~second indicia of said label-retaining space comprises at least one of a numeral and a letter of the alphabet.

11. (Once Amended) The customer registration system of claim 1,15, wherein said registration log ~~resides in~~comprises a spiral bound book.



## SPECIFICATION

### Markup of Lines 15 through 25 of Page 4

Generally, the present invention comprises a customer registration system and corresponding method of use. The customer registration system includes a plurality of registration labels and a registration log. The registration labels are arranged sequentially on and are detachable from a first substrate, such as conventional laser label stock or other conventional release-backing paper stock. Each of the registration labels includes a unique indicia that corresponds to a position of the label in the sequential arrangement of labels. For example, each label may be numbered in a corner of the label. Each label further includes at least one field having adequate area for the customer to enter his or her information (e.g., name, doctor, insurance carrier, and so forth) on the registration label.

## SPECIFICATION

### Markup of Lines 5 through 25 of Page 6

The patient registration or "sign-in" system of the present invention preferably includes two complimentary items: patient sign-in labels and a registration log. FIG. 1 illustrates an exemplary substrate 100 that includes a plurality of registration labels 101-120 in accordance with a preferred embodiment of the present invention. As depicted in FIG. 1, there is preferably one set of twenty (20) labels 101-120 to each standard 8.5 inch wide by 11 inch long (approximately 21.6 centimeter (cm) wide by 27.9 cm long) substrate 100 or carrier sheet. ~~Each~~As noted above, each label 101-120 preferably includes adequate area for the customer to enter information thereon. In the preferred embodiment shown in Fig. 1, each label 101-120 is preferably provided such an area in the form of a field 124 printed with designated spaces for the patient's name, the name of the patient's physician, and the patient's time of arrival, and further includes two check boxes. One check box is to be checked if the patient has changed his or her address and the other check box is to be checked if the patient has changed insurance. In addition, each label 101-120 preferably includes a unique indicia 122, such as a numeral, letter of the alphabet, an alpha-numeric combination, or any other indicia, in the upper left-hand corner of the label 101-120. Based on the indicia 122, the labels 101-120 are preferably arranged sequentially in two columns, with labels 101-110 being arranged from top to bottom of the left-hand column and labels 111-120 being arranged from top to bottom of the right-hand column as shown in FIG. 1. The indicia 122 preferably provides a unique identification of each label 101-120 in a particular set of labels (e.g., set of

## SPECIFICATION

### Markup of Lines 4 through 13 of Page 11

As briefly noted above, security features have been incorporated into the registration system of the described embodiments of the present invention. One such feature is the full set of instructions 201-207 which are preferably printed on the inside surface of the cover 200 of the logbook. This feature insures that each user understands how the system works. A second security feature is the provision of corresponding indicia on the labels 101-120 and the label-retaining spaces 301-320 to insure each label 101-120 is placed in the appropriate space 301-320 of the log. Lastly, the pages in the log include sequential indicia 328 (e.g., are numbered from 1-100), rendering the log book tamper resistant.

~~FTL1 #621397 v1~~FTL1 #621397 v1